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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,518	04/01/2004	Dwight Leung	17341-002001	4874
20985	7590	07/25/2006	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SILBERMANN, JOANNE	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/817,518	LEUNG, DWIGHT	
	Examiner	Art Unit	
	Joanne Silbermann	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Claim 1 is objected to because of the following informalities: the Specification does not provide basis for "a housing portion". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 depends from claim 3, which has been canceled. For purposes of examination, it is assumed that claim 9 depends from claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1, 4, 5 and 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Runge, Patent Publication US 2003/0131513 A1.
6. Runge teaches a toy comprising housing portion 50 (Figure 1) formed of material that is flexible and soft (paragraph 73) and includes lip surface 52 defining a perimeter (Figure 3) having first and second facing surfaces. Picture holding portion 60 includes front portion 10 attached to rear portion 40 thereby forming an area therebetween for a picture such as 30 (Figure 2). The lip surface extends continuously around the perimeter (Figure 1), but frame 50 may be intermittent or discontinuous (paragraph 150).
7. The picture holding portion may be made of glass (paragraph 127) which is rigid and transparent.
8. Frame 50 is round (Figure 1) but may be any geometric shape (paragraph 73).
9. Runge discloses a method of assembling the device (paragraph 96) including placing display element 30 between the first and second sheets of clear material.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6, 7 and 9 (as best as can be understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Runge in view of Loersch, US #3,681,866.

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12. Runge does not teach the front and rear picture holding portions as having a beveled connection providing space for a picture, however this is well known in the art as shown by Loersch. Loersch teaches a mount for a display including front and rear holding portions (Figure 4) having beveled areas 12 and 15 that are uneven so as to provide space 22 therebetween. It would have been obvious to a person having ordinary skill in the art to utilize such bevels in the display holder of Runge so as to provide front and rear portions that are held together as well as provide space for a display.

13. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Runge in view of Herbst, US #3,669,117.

14. Runge does not teach bumps on one surface or a holding loop. Runge does discuss frame 50 as having any desired overall shape and possibly a shape different from the picture holding portions (paragraphs 150-152). Bumps on the surface of such a device are well known, as shown by Herbst. Herbst teaches a toy including bumps 32 (Figure 1) and hanger loop 35. It would have been obvious to one of ordinary skill in the art to utilize bumps and a loop on the device of Runge so as to make the device easier to hold (in the shower or other wet environments, as discussed in paragraph 81) and to provide an easy means for supporting the device either for storage or for display.

Response to Arguments

15. Applicant's arguments filed 15 May 2006 have been fully considered but they are not persuasive.

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16. Applicant argues that Runge is not a toy. As stated in the above rejection, all of the structural elements of the claim are met by the reference. The designation of the frame as a toy refers to the intended use of the article only.

17. Applicant argues that the teaching in Runge that the frame may be intermittent must be wrong. The examiner believes that paragraph 150 of Runge clearly states that frame 50 may be intermittent or discontinuous. It appears that this is intended to be a variation of the frame described elsewhere in the Publication.

18. Applicant argues that the combination of Runge and Herbst should not be made. Runge clearly states that the frame may have various shapes (paragraph 151) and Herbst shows a particular shape.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silbermann
Primary Examiner
Art Unit 3611

js
20 July 2006